

Remarks

In the present Office Action, the Examiner rejected all of the present claims were rejected under 35 USC 102(b) as being anticipated by US Patent 5,912,205 to Lakes et al (hereinafter the '205 patent) or under 35 USC 103(a) as being unpatentable over the '205 patent either alone, or in conjunction with one or more secondary references. By the present response, none of the claims have been amended.

All of the claims of the present invention require the two security coatings, where one is on top of the other, and each provide a separate indicia of tampering, one sensitive to a solvent and the other sensitive to abrasion. The '205 patent teaches a heat-resistant security coating for use on security documents being printed through laser printers and other heated printing devices. The coating (described as a color-forming composition) is sensitive to solvents, abrasion and heat. It further teaches the coating may be in the form of warning indicia (e.g., VOID), authenticating indicia (e.g., VALID), or both.

There is nothing in the '205 patent that teaches the claimed invention. At most, the '205 patent teaches two coating compositions with messages that are interspersed with one another and adjacent one another, but not on one another. The '205 patent teaches an additional insulating material **15**, as well as a toner-adhesion enhancing coating **16** (as shown in FIG. 1 of the '205 patent).

Even though the toner-adhesion enhancing coating **16** is depicted as being a separate layer that is on top of the tamper-evident coating **14**, there is no indication that it provides evidence of tampering. In fact, its only apparent purpose is to provide "improved adhesion of toner particles to the security document when printed with a laser or other noncontact printer" as described at column 3, lines 5 through 7. Thus, the Examiner cannot rely on the presence of the toner-adhesion enhancing coating **16** to teach the claimed features.

Likewise, even if the insulating material 15 were a coating (which by referring to FIG. 1 it can clearly be seen that it is not), there is nothing to indicate that it produces separate indicia of tampering. At most, the insulating material 15, upon removal, allows color formers and color developers to either come in contact with one another or be exposed to an abrasion, heat or solvent condition that facilitates their combination and subsequent color formation. Even though the '205 patent teaches different indicia (i.e., warning indicia 32 and authentication indicia 34) that are present on the same side of a single substrate, it does not teach these coatings being one on top the other. Instead, it shows (as separate embodiments) (1) warning indicia and authentication indicia of the same composition that are in separate portions of the substrate, (2) warning indicia and authentication indicia of a single composition that are in an interspersed pattern, and (3) warning indicia and authentication indicia of different compositions. None of these embodiments even remotely suggest the idea of layered coatings one on top of the other to produce the claimed security document. As such, the present anticipatory rejection is improper, as it the '205 patent does not disclose each and every positively recited limitation. See, e.g., *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990) and MPEP 2131.

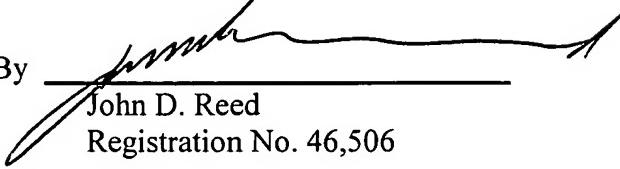
Moreover, the '205 patent is inappropriate as an obviousness rejection. One of the requirements of a prima facie case for obviousness is that all of the claim limitations must be taught or suggested (MPEP 2143.03), and on its face the '205 patent fails this requirement for the reasons discussed above. Since none of the secondary references (including Taylor et al (US 6,062,604), Berson (US 5,932,870), Halbrook, Jr. et al (US 5,883,043) or Lu (US 5,591,527)) correct this deficiency, the Applicants respectfully submit that the present obviousness rejection is not well taken, and that upon reconsideration by the Examiner should be withdrawn.

In conclusion, since neither a proper anticipatory rejection nor a prima facie case for obviousness has been presented against any of the independent claims 1, 33 or 43, the Applicants respectfully submit that they are in condition for allowance. Furthermore, since all of the claims that depend from the independent claims place further limits thereon, the Applicants are of the belief that they too are in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, notification of allowable subject matter is respectfully solicited.

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Respectfully submitted,  
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